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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,407	05/25/2000	David L. Bates	TMC-101US	7415

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BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE, WI 53202

EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/579,407

Applicant(s)

BATES ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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Claims 1-24 have been examined.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

4. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

5. In the present case, claims 1, 11, and 20 only recites an abstract idea. The recited steps of merely obtaining information about an applicant for a loan, underwriting an insurance risk, and providing an insurance quote do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to provide an insurance quote using information provided by an applicant for a loan. Furthermore, claims 2-20, 12-19, and 21-24 fail to remedy the deficiencies of claims 1, 11, and 20.

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6. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-24 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 7, 8, 11-14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lloyd, U.S. Patent No. 4,876,648.

9. As per claim 1, Lloyd teaches a method of generating an insurance quote for an applicant for a loan comprising the steps of: obtaining data from a lender, at least a portion of the data being provided to the lender by the applicant (see column 18, lines 52-57); underwriting an insurance risk responsive to the data (see column 6, lines 40-51); and providing an insurance quote to the applicant (see column 6, lines 40-51).

10. As per claim 2, Lloyd teaches the method of claim 1 as described above, wherein the insurance quote is provided by the lender (see column 6, lines 19-22 and lines 40-51, both the lender and insurance provider has access to the service computer where the insurance quote is stored).

11. As per claim 3, Lloyd teaches the method of claim 1 as described above, wherein the insurance quote is provided by the an insurance provider (see column 6, lines 19-22 and lines

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40-51, both the lender and insurance provider has access to the service computer where the insurance quote is stored).

12. As per claim 4, Lloyd teaches the method of claim 1 as described above, wherein the step of underwriting the insurance risk includes the additional steps of: providing a plurality of insurance companies for underwriting the insurance risk (see column 18, lines 42-51); and determining a set of terms for each of the plurality of insurance companies for which each of the plurality of insurance companies will accept the insurance risk (see column 18, lines 57-62).

13. As per claim 5, Lloyd teaches the method of claim 4 as described above, comprising the additional step of selecting one of the sets of terms and providing the insurance quote in response thereto (see column 19, lines 21-30).

14. As per claim 7, Lloyd teaches the method of claim 1 as described above, comprising the additional steps: storing the data after providing the insurance quote (see column 18, lines 55-56); and providing an additional insurance quote in response to a request by the applicant (see column 17, lines 41-46).

15. As per claim 8, Lloyd teaches the method of claim 1 as described above, comprising the additional step of requesting permission from the applicant prior to obtaining the data from the lender (see column 30, lines 15-16).

16. As per claim 11, Lloyd teaches a method of generating an insurance quote for an applicant for a loan, comprising the steps of: obtaining data from a lender, at least a first portion of the data being provided to the lender by the applicant in order to obtain the loan (column 18, lines 52-57); underwriting an insurance risk responsive to the data for a plurality of insurance companies (see column 18, lines 42-52); selecting one of the plurality of insurance companies in response to the underwriting and providing the same as a selected insurance company (see

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column 18, lines 57-62); and providing an insurance quote to the applicant from the selected insurance company (see column 6, lines 40-51).

17. As per claim 12, Lloyd teaches the method of claim 11 as described above, wherein the insurance quote is provided by the lender (see column 6, lines 19-22 and lines 40-51, both the lender and insurance provider has access to the service computer where the insurance quote is stored).

18. As per claim 13, Lloyd teaches the method of claim 11 as described above, wherein the insurance quote is provided by the an insurance provider (see column 6, lines 19-22 and lines 40-51, both the lender and insurance provider has access to the service computer where the insurance quote is stored).

19. As per claim 14, Lloyd teaches the method of claim 11 as described above, wherein the step of underwriting the insurance risk includes the additional step of determining a set of terms for each of the plurality of insurance companies under which each of the plurality of insurance companies will accept the insurance risk (see column 18, lines 57-62).

20. As per claim 16, Lloyd teaches the method of claim 11 as described above, comprising the additional steps: storing the data after providing the insurance quote (see column 18, lines 55-56); and providing an additional insurance quote in response to a request by the applicant (see column 17, lines 41-46).

21. As per claim 17, Lloyd teaches the method of claim 11 as described above, comprising the additional step of requesting permission from the applicant prior to obtaining the data from the lender (see column 30, lines 15-16).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 6, 15, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd, U.S. Patent No. 4,876,648.

24. As per claim 6, Lloyd teaches the method of claim 1 as described above. Lloyd does not explicitly teach the additional step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant. However, for the system to underwrite the insurance policy, it requires borrower information including age, sex, and rating (see column 18, lines 52-57). If any of this information is missing, the system cannot continue through the steps of underwriting the insurance policy. Therefore, it would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant. One of ordinary skill in the art would have been motivated to include this step in the system of Lloyd for the purpose of ensuring that an accurate policy premium is provided.

25. As per claim 15, Lloyd teaches the method of claim 11 as described above. Lloyd does not explicitly teach the additional step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant. However, for the system to underwrite the insurance policy, it requires borrower information including age, sex, and rating (see column 18,

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lines 52-57). If any of this information is missing, the system cannot continue through the steps of underwriting the insurance policy. Therefore, it would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant. One of ordinary skill in the art would have been motivated to include this step in the system of Lloyd for the purpose of ensuring that an accurate policy premium is provided.

26. As per claim 20, Lloyd teaches a method of generating an insurance quote for an applicant for a loan, comprising the steps of: requesting permission from the applicant to obtain data from a lender (see column 30, lines 15-16); obtaining data from a lender, at least a first portion of the data being provided to the lender by the applicant in order to obtain the loan (column 18, lines 52-57); underwriting an insurance risk responsive to the data for a plurality of insurance companies (see column 18, lines 42-52); selecting one of the plurality of insurance companies in response to the underwriting and providing the same as a selected insurance company (see column 18, lines 57-62); and providing an insurance quote to the applicant from the selected insurance company (see column 6, lines 40-51); storing the data after providing the insurance quote (see column 18, lines 55-56); and providing an additional insurance quote in response to a request by the applicant (see column 17, lines 41-46).

27. Lloyd does not explicitly teach the additional step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant. However, for the system to underwrite the insurance policy, it requires borrower information including age, sex, and rating (see column 18, lines 52-57). If any of this information is missing, the system cannot continue through the steps of underwriting the insurance policy. Therefore, it would have been obvious

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to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant. One of ordinary skill in the art would have been motivated to include this step in the system of Lloyd for the purpose of ensuring that an accurate policy premium is provided.

28. As per claim 21, Lloyd teaches the method of claim 20 as described above, wherein the insurance quote is provided by the lender (see column 6, lines 19-22 and lines 40-51, both the lender and insurance provider has access to the service computer where the insurance quote is stored).

29. As per claim 22, Lloyd teaches the method of claim 20 as described above, wherein the insurance quote is provided by the an insurance provider (see column 6, lines 19-22 and lines 40-51, both the lender and insurance provider has access to the service computer where the insurance quote is stored).

30. Claims 9, 10, 18, 19, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd, U.S. Patent No. 4,876,648 in view of Dugas, **Not the total solution Bankruptcy stays on credit reports.**

31. As per claim 9, Lloyd teaches the method of claim 1 as described above. Lloyd does not explicitly teach that a second portion of the data is obtained from a third party. Dugas discloses third party reporting of information for an application for life insurance (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of obtaining data in the system of Lloyd from a third party as disclosed by Dugas. One of ordinary skill in the art would have been motivated to perform such

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a step for the purpose of determining applicant's who pose a bad credit risk (see paragraph 8 of Dugas).

32. As per claim 10, Lloyd in view of Dugas teach the method of claim 9 as described above. Dugas further discloses that the third party is a credit bureau (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing to include this step in the system of Lloyd for the reasons given above with respect to claim 9.

33. As per claim 18, Lloyd teaches the method of claim 11 as described above. Lloyd does not explicitly teach that a second portion of the data is obtained from a third party. Dugas discloses third party reporting of information for an application for life insurance (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of obtaining data in the system of Lloyd from a third party as disclosed by Dugas. One of ordinary skill in the art would have been motivated to perform such a step for the purpose of determining applicant's who pose a bad credit risk (see paragraph 8 of Dugas).

34. As per claim 19, Lloyd in view of Dugas teach the method of claim 18 as described above. Dugas further discloses that the third party is a credit bureau (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing to include this step in the system of Lloyd for the reasons given above with respect to claim 18.

35. As per claim 23, Lloyd teaches the method of claim 20 as described above. Lloyd does not explicitly teach that a second portion of the data is obtained from a third party. Dugas discloses third party reporting of information for an application for life insurance (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of obtaining data in the system of Lloyd from a third party as disclosed by Dugas. One of ordinary skill in the art would have been motivated to

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perform such a step for the purpose of determining applicant's who pose a bad credit risk (see paragraph 8 of Dugas).

36. As per claim 24, Lloyd in view of Dugas teach the method of claim 34 as described above. Dugas further discloses that the third party is a credit bureau (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing to include this step in the system of Lloyd for the reasons given above with respect to claim 18.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Dillard teaches a system for providing a loan and insurance coverage from a single entity.
- Jones et al. teach a system for automatically determining status of a potential borrower.
- Kelly et al. teaches a system for implementing a bank owned life insurance policy.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

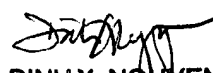
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40. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



CLG

April 7, 2003



DINH X. NGUYEN
PRIMARY EXAMINER